

REMARKS

In the Office Action the Examiner objected to the Specification, objected to the Drawings, objected to claims 19 and 27, rejected claims 6-11 and 15 under 35 U.S.C. § 112, ¶ 2, and rejected claims 1-27 under 35 U.S.C. § 103 as being unpatentable over Gogan et al. and Meng, etc.

Applicant has amended the Specification, the Drawings, and claims 19 and 27 to resolve the Examiner's concerns. Claims 6, 10 and 15 have also been amended to resolve the concerns under section 112.

Before discussing the rejections based on 35 U.S.C. § 103, it is thought proper to briefly state what is required to sustain such a rejection. The real issue under Section 103 is whether the Examiner has stated a case of prima facie obviousness.

The PTO has the burden under section 103 to establish a prima facie case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (citations omitted). In establishing a prima facie case of obviousness, the PTO "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." Id. at 1600. While Applicant admits that virtually every element of a claim may be found somewhere in the prior art, this is not the test to determine whether the prior art renders the invention obvious. Rather, "[t]he test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made." Connell v. Sears, Roebuck & Co., 220 U.S.P.Q. 193, 199 (Fed. Cir. 1983).

Applicant believes that the Examiner has failed to make a prima facie case of obviousness in that he has failed to show either (a) some objective teaching in the prior art that suggests combining the references, or (b) knowledge generally available to one of ordinary skill in the art which would lead that individual to combine the relevant teachings of the references to achieve the invention claimed. See In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

When making a rejection under 35 U.S.C. § 103 there are three fundamental areas the Examiner is required to cover under 37 CFR § 1.106 and MPEP § 706.02. First, the rejection should set forth the differences between the claims and the prior art. Second, the proposed modification of the applied references necessary to arrive at the claimed subject matter should be set out. Third, there must be an explanation as to why such proposed modifications would be obvious. With the above background in mind, the rejections under 35 U.S.C. § 103 will be discussed.

Applicant respectfully traverses the rejection of claims 1-27 as being obvious over the cited prior art, as Applicant submits that the Office Action fails to make a *prima facie* case of obviousness.

Regarding claims 1-7,12-13, 17-19 and 21-24, Applicant respectfully traverses the rejection as failing to show a *prima facie* case of obviousness. As noted above, the Patent Office must establish obviousness by showing either an teaching in the references to make the suggested modifications, or show knowledge which is generally available to those skilled in the art which suggests the combination.

The Office Action fails to identify any teaching in either reference with suggests the combination. The Office Action also fails to identify any other reason why one skilled in the art of making motorcycle parts would combine the two references as suggested by the

Examiner. To the contrary, Applicant submits that Meng is not even analogous art. Meng relates to connections for scaffolding, not to motorcycle parts. Thus, one skilled in the art would not even be charged with knowing of Meng, let alone having some knowledge not expressed by the Examiner as to why the references would be combined.

In addition to the lack of any express or implied suggestion of the combination, and Meng's status as non-analogous art, there is the fundamental fact that the combination suggested by the Examiner is inconsistent with the teachings of the primary reference - Gogan et. al.

In the first paragraph of the Summary of the Invention, Gogan et al. note:

"The sissy bar of the present invention generally includes a sissy bar and a latching means mounted on the sissy bar for **automatically** securing the sissy bar to the mounting means upon movement of the sissy bar toward the mounting means."

Col. 1, lines 46-50 (emphasis added).

The first paragraph of the Detailed Description further explains:

"The sissy bar assembly 10 includes a sissy bar 22 and latching means consisting of latching assemblies 23 mounted on each of the lateral sides of the sissy bar 22 for automatically securing the sissy bar 22 to mounting means 18 and 20 extending from the motorcycle frame 24 upon pivotal movement of the sissy bar 22 about the rear mounting means 18 and toward the front mounting means 20. As used herein, the term "automatically" means that the latching means 23 is designed such that the sissy bar 22 need only be pivoted toward the rear mounting means 20 in order to cause the latching assemblies 23 to engage. That is, there is no need to manually move or release the latching

assemblies 23 in order to secure the sissy bar 22 to the mounting means 18 and 20.”

Col. 3, lines 10-23.

Having taught a latching mechanism in which “there is no need to manually move or release the latching assemblies in order to secure the sissy bar to the mounting means”, Gogan et al. cannot be said to teach the combination suggested the Examiner. To the contrary, Gogan et al. must be said to teach away from the combination suggested by the Examiner, as it suggests that a mechanism such as Meng, which requires release of the latching mechanism, is inferior. Thus, claims 1 and 21, and all claims depending therefrom, should be allowed.

While all of the claims are allowable as set forth above, Applicant deems it necessary to point out further inconsistencies in the obviousness rejection. With respect to claims 6, 7 and 12, it is asserted that Gogan et al. teaches a locking means. While this is true, the argument misses the fact that the latching mechanism of Gogan et al. has been replaced (pursuant to the Examiner’s proposed modification) by the pin of Meng. Thus, once Gogan et al. has been modified as set forth with respect to claim 1, it would no longer have a locking means. Furthermore, the locking means of Gogan et al. would not work with Meng, as the locking means of Gogan et al. resides in the latching mechanism and engages the mounting means to prevent it from being removed from the latching mechanism by rotation of the latching mechanism. Such a configuration would not work in Meng. Thus, one skilled in the art would not make the modifications suggested by the Examiner.

With respect to claim 19, while the Examiner cites In re Harza for the proposition that repeating an element is a design consideration, the Examiner has failed to identify any reason, absent the teachings of the present invention, for such a modification.

With respect to claims 8-11, 14-16 and 25-27, Applicant further traverses the rejection. First, there is no teaching in any of the three references which suggests the combination. To the contrary, Munson is non-analogous art. There is simply no reason why a person attempting to form an improved sissy bar attachment would combine a motorcycle part with a part from a piece of scaffolding, with a bolt-less hinge for awnings and the like. Such a combination, with no teachings in the references to suggest the combination, is hindsight reconstruction. Such an approach to formulating obviousness rejections has been repeatedly rejected by the Court of Appeals for the Federal Circuit. *See In re Fine, supra*.

Furthermore, the suggested combination selectively picks and chooses from the prior art with no explanation as to why some portions would be selected and others ignored. There must be an explanation why one skilled in the art would select those portions relied on by the Examiner, while ignoring the other teachings of the references. Applicant submits that if one skilled in the art were to attempt to combine the three references, he or she would achieve a substantially different invention than that set forth in the claims. Munson functions in a completely different way than either Gogan et al. or Meng. The Examiner cannot merely rely on the functions of the different elements of these three very different references. She must show how the modifications would work together to form the claimed invention. This has not been done.

Finally, Applicant disagrees with the characterization of Munson provided by the Examiner. The Examiner states the Munson teaches a side bracket plate 20 with a locking hole 24 and a locking pin 23 which extends into the locking hole to prevent movement of the handle 22. The very portion of the patent cited by the Examiner, however is inconsistent with this characterization. Item 23 is a arm which engages against a shoulder 24. Munson does not teach that the arm extends into a hole. To the contrary, the recess in the shoulder 24

receives the bar portion 14. Col. 3, lines 14-31. Thus, all of these claims are patentable over the prior art.

Thus, there is simply no teaching in any of the three references from different areas of art which suggests a combination which would fall within the scope of the claims.

With respect to claim 11, Applicant is unsure how it can be said that the handle in Meng slides along a guide channel which is a cylindrical hole through which the pin moves.

Turning now to the rejection of claim 20, Applicant traverses the rejection. As noted above, there must be some teaching in the prior art or knowledge which suggests one skilled in the art to combine motorcycle parts, scaffolding parts and inserts for fluid flow systems. There is simply no teaching identified which suggests the modification. The mere fact that prior art from different fields may teach an element is insufficient. There must be teachings to make the modifications suggested by the Examiner. At present, there is no reason provided that one skilled in the art would modify Gogan et al. as suggested - apart from Applicant's disclosure.

Throughout the Office Action the Examiner attempts to rely on the catch-all "therefore it would be obvious for one skilled in the art . . ." This approach has been specifically rejected by the Court of Appeals for the Federal Circuit.

In the first place, the level of skill in the art is a prism or lense through which a judge or jury views the prior art and the claimed invention. This reference point prevents these decides from using their own insight or, worse yet, hindsight, to gauge obviousness. Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment. See *W.L.Gore & Assocs., Inc. v. Garlock, Inc.* 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1993)("To imbue on of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of

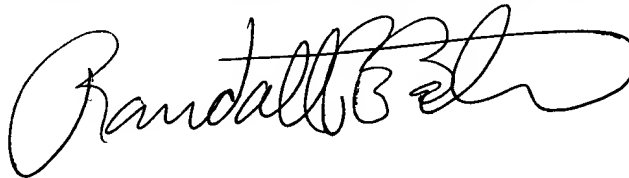
record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teaches.”) Skill in the art does not act as a bridge over gaps in substantive presentation of an obviousness case, but instead supplies the primary guarantee of objectivity in the process. *Al-Site Corp. v. VSI Internat’l, Inc.*, 50 U.S.P.Q.2d 1161, 1171 (Fed. Cir. 1999).

In light of the amended claims, and the revised specification and drawings, it is respectfully submitted that the claims are now in condition for allowance. Should the Examiner determine that any adverse action is necessary, it is requested that the Examiner contact Applicants’ attorney, Randall B. Bateman at (801) 478-0071 so that such matters may be resolved as quickly as possible.

A credit card authorization to cover the additional claims is included herewith. The Commissioner is hereby authorized to charge any amount owing or to credit any overpayment to Account No. 50-0881.

Respectfully Submitted,

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A handwritten signature in black ink, appearing to read "Randall B. Bateman", with a large, stylized flourish at the end.

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6. (Amended) The quick release system according to claim 1, further comprising a locking means.

10. (Amended) The quick release system according to claim 7, wherein the locking pin is spring loaded to bias the locking pin into the locking position.

15. (Amended) The quick release system according to claim 13, wherein the side bracket plate has a locking notch and wherein the locking pin extends into the locking notch to prevent movement of the slidable retaining means away from the second notch.

19. (Amended) The quick release system according to claim 17, wherein the bolt head further comprises a second annular channel.

27. (Amended) The side bracket plate according to claim 25, wherein the side bracket plate has a locking notch formed therein and wherein the locking pin is configured for advancement into the locking notch.

28. (New) A quick release system for mounting a backrest on a motorcycle, the system comprising:

a side bracket plate having a first, forward notch extending inwardly generally horizontally from a front end of the side bracket plate, and a second notch disposed adjacent a back end of the side bracket, extending generally upwardly into the side bracket plate from a bottom thereof, the first and second notches being configured to receive a bolt head;

a slidable retaining pin mounted to the side bracket plate, rearwardly from the second notch for selectively allowing movement of a bolt head into the second notch, the slidable retaining pin being movable between a first, forward position wherein the slidable retaining pin prevents advancement of a bolt head into and out of the notch, and a second position wherein the retaining pin allows movement of the bolt head into or out of the notch, and wherein the retaining pin is biased into the first position.

29. (New) The quick release system for mounting a backrest according to claim 28, further comprising a locking member for selectively preventing movement of the slidable retaining pin into the second position.

30. (New) The quick release system for mounting a backrest according to claim 29, wherein the slidable retaining pin is attached to a handle and wherein the locking member is disposed in the handle.

31. (New) The quick release system for mounting a backrest according to claim 30, wherein a locking notch is disposed in the side bracket plate and wherein the locking member is biased to extend into the locking notch.

32. (New) The quick release system for mounting a backrest according to claim 31, wherein the locking member moves perpendicular to the slidable retaining pin.

33. (New) The quick release system for mounting a backrest according to claim 28, further comprising a handle which slides along the side bracket plate.

34. (New) The quick release system for mounting a back rest on a motorcycle, comprising:

a side bracket plate configured for holding a backrest of a motorcycle, the side bracket plate having a first notch and a second notch formed therein, each for receiving a bolt head; and

a slidable retaining pin disposed adjacent at least one of the notches and movable between a first position wherein the slidable retaining pin prevents movement of a bolt head out of the at least one of the notches, to a second position allowing removal of a bolt head out of the at least one of the notches, so as to selectively prevent a bolt head from being slid out of the one of the notches.

35. (New) The quick release system according to claim 34, further comprising a locking member for selectively preventing movement of the slidable retaining pin into the second position.